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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,095	02/05/2004	John J. Hart III	ECD-0004CIP	3284
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MILLS & ONELLO LLP ELEVEN BEACON STREET SUITE 605 BOSTON, MA 02108				
EXAMINER				
BIBBINS, LATANYA				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/773,095

Applicant(s)

HART ET AL.

Examiner

LaTanya Bibbins

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-16, 18-24, 26-33 and 35-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-16, 18-24, 26-33 and 35-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In the remarks filed on May 2, 2008, Applicant amended claims 1, 12, 23, and 32, cancelled claims 6, 17, 25, and 34, and submitted arguments for allowability of pending claims 1-5, 7-16, 18-24, 26-33, and 35-47.

Response to Arguments

2. Applicant's arguments with respect to claims 41-47 have been considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 1-5, 7-16, 18-24, 26-33, and 35-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. New or amended claims which introduce elements or limitations which are not supported by the as-filed disclosure violate the written description requirement. See MPEP § 2163 I(B).

Regarding claims 1 and 12, in the amendment filed on April 5, 2007, independent claims 1 and 12, were amended to include the limitation “the modified region maintaining its optical characteristics following irradiation of the modified region during the read operation.” However, the specification does not disclose that the modified region maintains its optical characteristics following irradiation of the modified region during the read operation. Therefore, the claimed limitation “the modified region maintaining its optical characteristics following irradiation of the modified region during the read operation” of amended claims 1 and 12 is not supported by the as-filed disclosure, and the written description requirement is violated.

Dependent claims 2-5, 7-11, 13-16, 18-22, and 47 do not resolve the 35 U.S.C. 112 first paragraph issues of independent claims 1 and 12 recited above and are therefore rejected as incorporating the deficiencies of a claim upon which they depends.

Regarding claims 23 and 32, in the amendment filed on April 5, 2007, newly added independent claims 23 and 32 include the limitation “the modified region maintaining its optical characteristics following irradiation of the modified region during the read operation.” However, the specification does not disclose that the modified region maintains its optical characteristics following irradiation of the modified region during the read operation. Therefore, the claimed limitation “the modified region maintaining its optical characteristics following irradiation of the modified region during the read operation” of newly added claims 23 and 32 is not supported by the as-filed disclosure, and the written description requirement is violated.

Dependent claims 24, 26-31, 33, and 35-40 do not resolve the 35 U.S.C. 112 first paragraph issues of independent claims 23 and 32 recited above and are therefore rejected as incorporating the deficiencies of a claim upon which they depends.

Regarding claims 41 and 44, in the amendment filed on April 5, 2007, newly added independent claims 41 and 44 include the limitation "the distorted region maintaining its optical characteristics following irradiation of the distorted region during the reading operation." However, the specification does not disclose that the distorted region maintains its optical characteristics following irradiation of the distorted region during the reading operation. Therefore, the claimed limitation "the distorted region maintaining its optical characteristics following irradiation of the distorted region during the reading operation" of newly added claims 41 and 44 is not supported by the as-filed disclosure, and the written description requirement is violated.

Dependent claims 42, 43, 45, and 46 do not resolve the 35 U.S.C. 112 first paragraph issues of independent claims 41 and 44 recited above and are therefore rejected as incorporating the deficiencies of a claim upon which they depends.

Allowable Subject Matter

5. No statement will be made in this Office Action regarding the allowability over the prior art due to the 35 USC. 112 first paragraph rejections noted above.

Citation of Relevant Prior Art

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bakos et al. (Us PGPub Number 2003/0099186 A1) disclose systems and methods for inhibiting the readability of an optical media due to changes in a pseudo-reflective material that composes the optical media after the optical media has been exposed to air for a predetermined time. An optical media includes a data encoded component. At least a fraction of the data encoded component transforms from a substantially optically reflective state to a substantially optically non-reflective state as at-least-in-part a function of time from an initializing event. The systems and methods provide advantages because of low cost, limited content lifetime, avoidance of rental returns and minimum changes to existing manufacturing processes.

Gaston (US Patent Number 7,124,441 B1) discloses an optically readable memory that is usable in connection with a finite number of user machines. Generally, this is achieved by providing the optically readable memory with a vanishing code, usable to access information stored on the memory. The vanishing code is digitally written on the optically readable memory and is situated physically adjacent or proximal to an initially translucent mask layer. The mask layer is adapted to cause the vanishing code to become unreadable after at least one and possibly multiple readings by a user machine.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaTanya Bibbins whose telephone number is (571)270-

1125. The examiner can normally be reached on Monday through Friday 7:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571 272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LaTanya Bibbins/
Examiner, Art Unit 2627

/Wayne Young/
Supervisory Patent Examiner, Art Unit 2627